

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERND SCHRECKENBERG
and LUDGER SUDKAMP

Appeal No. 1999-2632
Application 08/707,097

ON BRIEF

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Bernd Schreckenbergs et al. appeal from the final rejection of claims 2 through 7, 9 through 15, 17 through 22, 24 and 32 through 44.¹ Claims 25 through 31, the only other

¹ Claims 18, 38 and 40 have been amended subsequent to final rejection.

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claims pending in the application, stand allowed.²

The invention relates to a manually-operable tablet dispenser. A copy of the claims on appeal appears in the appendix to the appellants' main brief (Paper No. 16).³

The references relied upon by the examiner as evidence of obviousness are:

Meshberg 1987	4,696,415	Sept. 29,
Tieke et al. (Tieke) 1992	5,108,006	Apr. 28,

Claims 2 through 7, 9 through 15, 17 through 22, 24 and 32 through 44 stand rejected under 35 U.S.C. § 103(a) as being

²Although claim 31 was rejected in the final rejection (Paper No. 12), it has since been allowed by the examiner in amended form (see page 2 in the examiner's answer, Paper No. 17).

³Our review of the claims shows the presence of a number of minor inconsistencies in terminology which are deserving of correction in the event of further prosecution. By way of example, the terms "the sliding part," "the second end of the actuating bar" and "the base part" in claim 2 lack a proper antecedent basis.

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unpatentable over Tieke in view of Meshberg.

Reference is made to the appellants' main and reply
briefs (Paper Nos. 16 and 18) and to the examiner's answer
(Paper No.

17) for the respective positions of the appellants and the examiner regarding the merits of this rejection.

Tieke, the examiner's primary reference, discloses a tablet dispenser which is similar in many respects to the tablet dispenser disclosed and claimed by the appellants. The central issue in this appeal involves the undisputed failure of Tieke to teach or suggest structure responsive to the limitations in the claims corresponding to the appellants' resilient resetting cover 3. These limitations take different forms in the five independent claims on appeal, to wit: "a cover . . . having an upwardly concave curved portion and composed of a resilient material having structural memory to reset after being pushed" (claims 9 and 32); "a resiliently resetting press portion . . . sealingly connected to the housing and resiliently movable relative thereto" (claim 18); "a cover . . . having an upwardly concave curved portion of soft-elastic plastic material . . . wherein the upwardly concave curved portion of the cover acts as a resilient restoring element for the dispenser element" (claim 24); and

"a resiliently resetting press portion . . . hermetically sealingly connected to the housing and resiliently moveable relative thereto" (claim 40). In contrast, the corresponding cover component (56, 156) in Tieke's tablet dispenser is not disclosed as being resilient/elastic and is reset via a remote biasing means (80, 180). The examiner has turned to Meshberg to cure this deficiency.

Meshberg pertains to vacuum pump dispensers for viscous products. The Figure 10 embodiment relied upon by the examiner includes a cylinder 190, a piston 196, a pumping compartment 225, a dispensing spout 210 and a flexible dome 218. Pressing the dome forces a dose of the product from the pumping compartment through the dispensing spout, and releasing the dome allows it to resume its normal shape and draws an additional dose of the product into the pumping compartment (see column 8, line 62 through column 9, line 61).

In proposing to combine Tieke and Meshberg, the examiner explains that

Tieke et al. discloses all elements per claimed invention with the exception of a plastic cover acting as an actuating means. However, it would have been obvious for a person with ordinary skill in the art to supply such a cover because it facilitates the actuation or spring back means for a stem or follower means, as taught by Meshberg. Furthermore Tieke et al. and Meshberg's actuating means are art recognized to be functionally equivalent in providing spring back action. Thus one of ordinary skill in the art would have found it obvious to substitute [for] Tieke et al.'s spring [the] Meshberg leaf spring (actuating cap). Such modification of Tieke et al.'s device will also reduce manufacturing cost by simplifying of the actuation means [answer, pages 4-5, 7 and 9-10].

The mere fact that the prior art could be so modified, however, would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The reasons advanced by the examiner as to why the proposed modification of the Tieke dispenser would have been desirable are not well taken.

To begin with, the examiner has not explained, nor is it apparent from the references, why Meshberg's resilient dome/cover would facilitate the "spring back" action of the

Tieke dispenser to any degree greater than Tieke's remote biasing means. Further, the references do not establish that the "spring back" elements respectively disclosed therein are art recognized functional equivalents. Even if functional equivalence were established, however, it would not be dispositive of the obviousness issue at bar. Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. In re Scott, 323 F.2d 1016, 1019, 139 USPQ 297, 299 (CCPA 1963). Finally, the examiner's determination that the proposed modification of the Tieke dispenser would reduce its manufacturing cost has no factual support in the record.

Although the Tieke and Meshberg devices are both "dispensers" in a broad sense, they are designed to dispense decidedly different products in decidedly different ways. Given the disparate natures of these devices and the unconvincing rationale advanced by the examiner, we are led to conclude that the proposed combination of Tieke and Meshberg is based on an impermissible hindsight reconstruction of the

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claimed invention.

Accordingly, we shall not sustain the standing 35 U.S.C.
§ 103(a) rejection of independent claims 9, 18, 24, 32 and
40, or of claims 2 through 7, 10 through 15, 17, 19 through
22, 33 through 39 and 41 through 44 which depend therefrom, as
being unpatentable over Tieke in view of Meshberg.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)
Administrative Patent Judge)

LAWRENCE J. STAAB)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND

INTERFERENCES

JOHN P. McQUADE)
Administrative Patent Judge)

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